

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

HONEYWELL INTERNATIONAL INC. )  
and HONEYWELL INTELLECTUAL )  
PROPERTIES INC., )  
Plaintiffs, ) C.A. No. 04-1338-\*\*\*  
v. ) CONSOLIDATED  
APPLE COMPUTER, INC., et al., ) PUBLIC VERSION  
Defendants. )

**LETTER TO THE HONORABLE MARY PAT THYNGE  
FROM THOMAS C. GRIMM REGARDING DEFENDANTS'  
MOTION TO COMPEL DISCOVERY CONCERNING LG PHILIPS**

OF COUNSEL:

Martin R. Lueck  
Matthew L. Woods  
Stacie E. Oberts  
Denise S. Rahne  
Peter N. Surdo  
Marta M. Chou  
ROBINS, KAPLAN, MILLER & CIRESI L.L.P.  
800 LaSalle Avenue  
Minneapolis, MN 55402-2015  
(612) 349-8500

MORRIS, NICHOLS, ARSHT & TUNNELL LLP  
Thomas C. Grimm (#1098)  
Benjamin J. Schladweiler (#4601)  
1201 N. Market Street  
P.O. Box 1347  
Wilmington, DE 19899-1347  
(302) 658-9200  
tgrimm@mnat.com  
bschladweiler@mnat.com

*Attorneys for Plaintiffs*

Anthony A. Froio  
Marc N. Henschke  
Alan E. McKenna  
Michael J. Garko  
ROBINS, KAPLAN, MILLER & CIRESI L.L.P.  
800 Boylston Street, 25<sup>th</sup> Floor  
Boston, MA 02199  
(617) 267-2300

Confidential Version Filed: November 20, 2007

Public Version Filed: December 13, 2007

Dear Magistrate Judge Thynge:

**I. Samsung SDI's Request to Disclose Enumerated Details REDACTED to In-House Counsel Should be Denied**

a. REDACTED

REDACTED

Hitachi raised the same issue in January, 2007. The parties exchanged numerous correspondence, and had numerous telephone conversations regarding this issue since February, 2007.

REDACTED

or any summary of it, and how Samsung's "need" outweighed Honeywell's right to protect the information pursuant to the Protective Order.

REDACTED

(emphasis supplied.) When Honeywell demanded factual support for its claim of patent misuse, Samsung provided no basis whatsoever. Rather, it then sought to disclose a summary of key portions REDACTED in the form contained on Page 2 of Samsung's letter brief (the "Summary").

Samsung erroneously argues that Honeywell has provided "no justification" for its claim that the alleged facts contained in Samsung's Summary are appropriately designated as "Highly Confidential – Outside Attorneys' Eyes Only."

REDACTED

The best Samsung can do is allege that the REDACTED *could potentially* form the basis for a patent misuse claim, yet refuses to detail how and misstates the terms of the agreement.

b. *Samsung's Proposed Summary Misstates the Terms of the* REDACTED

Samsung's proposed Summary misstates the provisions of the REDACTED Specifically, Samsung's statement regarding paragraph 3 of the Summary is false, and an intentional misreading of the agreement.

REDACTED

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REDACTED

In fact, a reading of § 2.9 as originally drafted in the 2003 License makes no sense whatsoever.

REDACTED

referenced by Samsung corrected the error in § 2.9, and otherwise reinforced the remaining provisions of the

REDACTED

Samsung has offered no evidence whatsoever to contradict Honeywell's explanation and understanding of these provisions. Tellingly, Samsung has undertaken no other discovery in this regard.

REDACTED

Because Samsung has no basis for its position that  
REDACTED

any patent misuse claim is baseless and without merit. Samsung's citations to *United States v. Krasnov* and *United States v. Besser Mfg. Co.* are inapposite.

c. *Samsung's Request is Untimely and Prejudicial to Honeywell*

Samsung's request at this late date should be denied because it is untimely and prejudicial to Honeywell. Samsung, and other defendants, first raised issues relative to the disclosure of REDACTED well over 9 months ago and have just now sought relief from this Court. Even if Samsung could provide a factual basis to assert a patent misuse claim against Honeywell, the time to amend its pleadings has long since passed. In fact, discovery is currently scheduled to close on December 20, 2007. Allowing Samsung to now amend its pleadings and assert any such claim would be prejudicial to Honeywell and should be denied.

**II. Honeywell's Communications REDACTED Are Protected By The Common Interest Privilege**

Honeywell has properly withheld on the grounds of privilege a number of communications between itself REDACTED that relate to the common interest Honeywell REDACTED share regarding the '371 patent. The common interest doctrine extends attorney-client privilege to communications between clients and attorneys "allied in a "common legal cause" . . . because it is reasonable to expect that parties pursuing common legal interests intended resultant disclosures to be [protected]." *Corning Inc. v. SRU Biosystems, LLC*, 223 F.R.D. 189, 190 (D. Del. 2004), quoting *In re Regents of the Univ. of Cal.*, 101 F.3d 1386, 1389 (Fed. Cir. 1996). This common interest may arise where two entities share a common legal or definable commercial interest and, therefore, share legal advice with respect to that common interest. See, e.g., *Hewlett Packard Co. v. Bausch & Lomb Inc.*, 115 F.R.D. 308, 309 (N.D. Cal. 1987) (finding a common interest between Bausch and Lomb and GEC,

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a prospective purchaser, with respect to a patent opinion letter, even where GEC later decided not to buy the division).

REDACTED

In this instance, Honeywell clearly share a common legal interest in the enforcement of the '371 patent by virtue of the financial provisions found

REDACTED

*Constar Int'l, Inc. v. Cont'l Pet Techs., Inc.*, 2003 U.S. Dist. LEXIS 21132, at \*5 (D. Del. Nov. 13, 2003), quoting *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1172 (D.S.C. 1975). In order for the common interest doctrine to apply, the common interest between two parties must be "legal and not solely commercial." *Corning*, 223 F.R.D. at 190. In *Constar*, the court held that parties engaging in a cross-license of patents had an identical legal interest in developing the patents to obtain the greatest amount of protection and in exploiting the patents. 2003 LEXIS 21132, at \*5.

REDACTED

REDACTED

While Honeywell has express

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, Samsung offers nothing similar to support its own contention that the common interest doctrine protects those communications, yet still asserts that it has sufficiently asserted privilege by means of common interest. (Ex. B.)

For the foregoing reasons, Honeywell respectfully requests that this Court deny Samsung's requests to compel production of these privileged documents.

Respectfully,

*/s/ Thomas C. Grimm*

Thomas C. Grimm (#1098)

TCG

Enclosures

cc: Dr. Peter T. Dalleo, Clerk (by hand delivery, w/encls.)  
 Richard L. Horwitz, Esquire (by e-mail & hand delivery, w/encls.)  
 Counsel of Record (by e-mail, w/encls.)

**CERTIFICATE OF SERVICE**

I certify that on December 13, 2007, I caused to be served true and correct copies of the foregoing on the following in the manner indicated:

**BY HAND & E-MAIL:**

Richard L. Horwitz  
David E. Moore  
POTTER ANDERSON & CORROON LLP  
Hercules Plaza, 6th Floor  
1313 N. Market Street  
P.O. Box 951  
Wilmington, DE 19899

*Attorneys for Samsung SDI America, Inc.  
and Samsung SDI Co., Ltd.*

**BY E-MAIL:**

Karen L. Pascale  
YOUNG CONAWAY STARGATT  
& TAYLOR, LLP  
The Brandywine Building, 17th floor  
1000 West Street  
Wilmington, DE 19801

*Attorneys for Optrex America, Inc.*

David J. Margules  
John M. Seaman  
BOUCHARD MARGULES  
& FRIEDLANDER, P.A.  
222 Delaware Ave., Suite 1400  
Wilmington DE 19801

*Attorneys for Citizen Watch Co., Ltd.  
and Citizen Displays Co., Ltd.*

Philip A. Rovner  
POTTER ANDERSON & CORROON LLP  
Hercules Plaza, 6th Floor  
1313 N. Market Street  
P.O. Box 951  
Wilmington, DE 19899

*Attorneys for FUJIFILM Corporation  
and FUJIFILM U.S.A., Inc.*

Daniel V. Folt  
Matt Neiderman  
DUANE MORRIS LLP  
1100 North Market Street, 12th Floor  
Wilmington, DE 19801-1246

*Attorneys for InnoLux Display Corporation*

Andrew M. Ollis  
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
1940 Duke Street  
Alexandria, VA 22314  
aollis@oblon.com

*Attorneys for Optrex America, Inc.*

Lawrence Rosenthal  
Matthew W. Siegal  
STROOCK & STROOCK & LAVAN LLP  
180 Maiden Lane  
New York, NY 10038-4982  
lrosenthal@stroock.com  
msiegal@stroock.com

*Attorneys for FUJIFILM Corporation  
and FUJIFILM U.S.A., Inc.*

Stephen S. Korniczky  
Elizabeth L. Brann  
PAUL, HASTINGS, JANOFSKY  
& WALKER LLP  
3579 Valley Centre Drive  
San Diego, CA 92130  
stephen.korniczky@paulhastings.com  
elizabeth.brann@paulhastings.com

Hamilton Loeb  
PAUL, HASTINGS, JANOFSKY  
& WALKER LLP  
875 15th Street, N.W.  
Washington, DC 20005  
hamiltonloeb@paulhastings.com

*Attorneys for Samsung SDI Co., Ltd.  
and Samsung SDI America, Inc.*

Stuart Lubitz  
HOGAN & HARTSON LLP  
1999 Avenue of the Stars, Suite 1400  
Los Angeles, CA 90067  
slubitz@hhlaw.com

*Attorneys for Citizen Watch Co., Ltd.  
and Citizen Displays Co., Ltd.*

Donald R. McPhail  
DUANE MORRIS LLP  
1667 K Street, N.W., Suite 700  
Washington, DC 20006  
drmcphail@duanemorris.com

*Attorneys for InnoLux Display Corporation*

**BY FEDERAL EXPRESS**

Mr. Seong Yoon Jeong  
Assistant Manager  
Technology Planning Group  
BOE HYDIS TECHNOLOGY CO., LTD.  
San 136-1, Ami-ri, Bubal-eub  
Ichon-si, Gyeonggi-do 467-701  
Republic of Korea

*/s/ Thomas C. Grimm*

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Thomas C. Grimm (#1098)